

Docket No.: 0020-5429PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Yuko SAWAKI et al.

Application No.: 10/551,188

Confirmation No.: 1816

Filed: September 29, 2005

Art Unit: 1794

For: COMPOSITE INDIUM OXIDE PARTICLE,
METHOD FOR PRODUCING SAME,
CONDUCTIVE COATING MATERIAL,
CONDUCTIVE COATING FILM, AND
CONDUCTIVE SHEET

Examiner: H. T. Le

LETTER REQUESTING INITIALED PTO SB-08 FORM,

AND CORRECTION OF ERRONEOUS STATEMENT IN JANUARY 22, 2008 REPLY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

(I.) Comments Regarding IDS of February 26, 2007

- Request for Initialed USPTO SB-08

An Information Disclosure Statement (IDS) was filed in the Information Disclosure Statement was filed in the matter of the instant application on February 26, 2007, which included a PTO SB-08 form listing the following 4 references.

**JP-3-33185-A
JP-2001-332134-A
JP-2000-119018-A
JP-2002-179948-A**

The 4 references were enclosed with the IDS, and each of the 4 references was cited in the English language "International Search Report" originally filed in the USPTO with the instant application on September 29, 2005.

However, the Examiner did not initial on the SB-08 form filed on February 26, 2007 that any/each of the references listed was considered; instead, the Examiner simply lined-through each of 4 listed references on the SB-08 form.

Furthermore, the Examiner thereafter rejected pending claims in the instant application over one of same the 4 listed references (*i.e.*, JP-3-33185-A) without apparently ever properly citing the same on a PTO-892 form.

Accordingly, the Examiner is earnestly solicited to provide a properly initialed copy of the SB-08 form enclosed with the earlier submitted IDS of February 26, 2007.

In this regard, the Examiner is specifically reminded of the provisions of MPEP § 609.04(a) III., which relates to "Content Requirements for an Information Disclosure Statement" and more particularly to providing a "Concise Explanation of Relevance for Non-English Language Information" and that states as follows:

...Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report.

Notably in the IDS filed on February 26, 2007 it was positively stated at page 2 thereof that "Each Japanese patent document submitted herewith is cited in the International Search Report, a copy of which was previously submitted on September 29, 2005." (Emphasis Added)

Submitted herewith is a copy of the Form PTO SB-08 which was submitted with the Information Disclosure Statement filed on February 26, 2007.

The Examiner is respectfully requested to initial the attached SB-08 Form and return one (1) copy of the same to the Applicants.

(II.) Correction of Erroneous Statement in January 22, 2008 Reply

- Comments Regarding IDS of April 14, 2006

In the reply of January 22, 2008 (at pages 9-10) applicants requested consideration of a Japanese reference that had previously been submitted to the USPTO in an IDS filed on April 14, 2006. The reference was JP 62-7627-A (a full copy of the reference had been filed in the USPTO with an English language Abstract thereof).

In the January 22, 2008 reply, at pages 9-10, the undersigned (through an inadvertent error), made the following erroneous statement.

Notably in the IDS filed on April 14, 2006 it was positively stated that "Each Japanese patent document submitted herewith is cited in the International Search Report, a copy of which was previously submitted on September 29, 2005."

The above statement was in error, since the references listed in the April 14, 2006 IDS were not cited in the International Search Report submitted on September 29, 2005.

The undersigned discovered the above error when reviewing the present application's file after issuance of the Notice of Allowance. At that time it was realized/discovered that it was actually the 4 references listed in the February 26, 2007 IDS that were cited in the International Search Report submitted on September 29, 2005.

In any event, after the Examiner considered the undersigned's January 22, 2008 reply, the Examiner provided (with the Notice of Allowance) a newly initialed copy of the USPTO SB-08 that had been originally submitted with the April 14, 2006 IDS; wherein each of the references listed thereon were now properly initialed (including the JP 62-7627-A reference, which had been originally filed in the USPTO with an English language Abstract thereof).

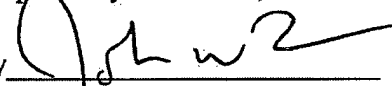
Accordingly, the JP 62-7627-A reference has been properly considered by the USPTO Examiner (as evidenced by the initialed SB-08 form enclosed with the Notice of Allowance).

Furthermore, it is submitted that above noted erroneous statement, occurring at pages 9-10 of the January 22, 2008 reply, does not negatively affect the validity and/or enforceability of any patent right associated with the instantly claimed invention.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated:

Respectfully submitted,

By 

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Enclosure: Copy of the Form PTO SB-08 originally submitted with the Information Disclosure Statement filed on February 26, 2007.